



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/252,842 02/19/99 STYLLI

C AUROBIO.014A

025290 IM22/0829
AURORA BIOSCIENCE CORPORATION
11010 TORREYANA RD
SAN DIEGO CA 92121

EXAMINER

BEX, P

ART UNIT

PAPER NUMBER

1743

DATE MAILED:

08/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/252,842

Applicant(s)

Stylli et al.

Examiner
Patricia Kathryn Bex

Group Art Unit
1743



☒ Responsive to communication(s) filed on May 24, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-23 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1743

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed May 24, 1999 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The Application is missing copies of documents: France, et al., "Proceedings of the International Symposium on Laboratory Automation and Robotics", 1992, pages 400-410, Goddard, et al." Proceedings of the International Symposium on Laboratory Automation and Robotics", 1992, pages 392-399., Schrodederand Neagle, J. Biomolecular Screening, 1:75-80, (1996), Shuttleworth, Inc., "Flexible, Low-Line Pressure Accumulating Slip-Torque Conveyor Systems" (ca. 1993), Shuttleworth, Inc., "Flat Panel Display News" February 1996.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1743

In claim 8, line 6, it is unclear as to what Applicant means by the limitation programmably integrated.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 8, 10-12, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishibashi (USP 5,087,423).

Ishibashi anticipates the instant claims by teaching an automatic analyzing apparatus comprising an automated, bi-directional, parallel transport path 58, 59, 60 programmably controlled by a CPU 66 to facilitate parallel processing of a plurality of sample wells (column 3, lines 23-25) and at least one workstation 51, 52, 53 operably linked and programmably integrated to the sample transport path (column 8, lines 22-43, Fig. 4).

6. Claims 8, 10 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ashihara *et al* (USP 5,158,895).

Ashihara *et al* teach an automatic automated transport apparatus for retrieving a plurality of sample wells from an addressable chemical storage module 31 (Fig. 1) with an automated

Art Unit: 1743

retriever 32 (column 15, line 37- column 16, line 22) and an screening sample transport pathway 71 separate from the automated retriever, and which delivers the set of sample wells to automated liquid handlers (pipettors) 16 a-c, which is programmably integrated to the screening sample transporter.

7. Claims 8, 10 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by MacIndoe, Jr (USP 5,332,549).

MacIndoe, Jr teaches an automated transport apparatus for retrieving a sample wells from a chemical storage comprising a plurality of storage locations (Fig. 1) with an automated retriever 23 (column 9, lines 39-51) which delivers the sample wells to a screening transporter pathway 37 separate from the automated retriever, which delivers the sample wells to workstations comprising automated liquid handlers (pipettors) 25 1-2, which is programmably integrated to the screening sample transporter.

8. Claims 8, 10-12, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mimura *et al* (USP 5,902,549).

Mimura *et al* anticipates the instant claims by teaching an automatic analyzing apparatus comprising an automated, bi-directional, parallel sample transporter 20, 25 programmably controlled by a CPU 40 to facilitate parallel processing of a plurality of sample wells 1 and at least one workstation 3A-3G operably linked to the sample transporter and programmably integrated to the sample transporter (column 3, line 26- column 11, line 24, Fig. 1).

Art Unit: 1743

Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7, 13-16 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi (USP 5,087,423) in view of MacIndoe, Jr (USP 5,332,549).

Ishibashi as discussed previously, does not teach a chemical library comprising storage locations and an automated multi-well receiver associated with the chemical library. MacIndoe, Jr. does teach a chemical library comprising a plurality of storage locations (Fig. 1) with an automated retriever 23 (column 9, lines 39-51) associated with the chemical library and which delivers the multi-well plates (Fig. 4) to a screening transporter pathway 37 separate from the automated retriever.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the automatic analyzing apparatus of Ishibashi, a chemical library comprising storage locations and an automated multi-well receiver associated with the chemical library, as taught by MacIndoe, Jr. so as not to require an operator to manually feed multi-well plates into the testing system (column 2, lines 21-32).

Art Unit: 1743

MacIndoe, Jr. does not explicitly teach the storage capacity of 1000 or 3000 multi-well plates. However, it would have been an obvious matter of design choice to one of ordinary skill in the art to include a storage module capable of storing 1000 or 3000 multi-well plates in order to increase the quantity of samples that a single laboratory can effectively handle without a loss in quality or increased error rates occurring due to increased throughput. Further, such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of Stylli et al. (USP 5,985,214) . Although the conflicting claims are not identical, they are not patentably distinct from each other because both

Art Unit: 1743

teach a chemical library storage module comprising storage locations for multi-well plates with an automated retriever, and an automated, bi-directional, parallel transport path and automated liquid handling devices.

Conclusion

13. Claims 1-23 are rejected.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are Pang *et al*, Wakatake (EPO 629858A1), Long, Inoue (JP 2-25755) Mitsumaki *et al* (EPO 795754 A2) and Glover *et al*. They are cited of interest in that they show various teachings of methods of retrieving a selected set of chemical compounds from an addressable chemical storage module with an automatic robotic retriever and delivering the set of chemical compounds to an automated transport pathway separate from the automated robotic retriever, and delivering the set of chemical compounds to automated liquid handlers.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Art Unit: 1743

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



P. Kathryn Bex
Patent Examiner
AU 1743
August 24, 2000



Jill Warden
Supervisory Patent Examiner
Technology Center 1700